

REMARKS

Claims 1, 20, 22, and 24 have been amended. Claims 1-3, 6 and 20-24 remain pending in the application.

The Rejection of Claim 22 Under 35 U.S.C. §102(e)

Claim 22 was rejected under 35 U.S.C. § 102(e) as being anticipated by Davis et al. (U.S. Pat. No. 5,647,724). Applicant respectfully traverses this rejection.

The Office Action states that "Davis et al. teach an apparatus comprising: a plurality of storage locations (22 & 23); a robotic apparatus (12) for transporting substrates or materials; and a chemical storage buffer (e.g., one of the two substrate holders 22 or 23 can perform independently of the other holder; therefore, one substrate holder can temporarily hold one substrate, while the other substrate retrieves another substrate)". The Office Action further stated that only structural limitations of the apparatus are considered in the patentability of the claims.

Axiomatically, rejection of a claim for anticipation by a reference requires that the reference explicitly or inherently describe all of the elements, limitations, and relationships recited in the claim.

Davis et al. discloses a substrate transport apparatus 12 with two substrate holders 22, 23. The substrate transport apparatus 12 is adapted to transport planar substrates between or among chambers 14 and elevator 16 (5,647,724 col. 2, lines 24-28). "The substrate holders 22, 23 are adapted to be inserted and removed from the chambers 14 and elevator 16. The holders 22, 23 are adapted to hold substrates thereon and thereby allow substrates to be moved between and/or among chambers 14 and elevators 16." (5,647,724 col. 4, lines 1-5). As disclosed in Davis et al., the substrate holders 22, 23 are used to retrieve and transport substrates. Nowhere in Davis et al. is there any disclosure of one of the substrate holders 22, 23 being described as a "chemical storage buffer".

In contrast, the present invention claims both “a moving automated chemical retriever” and “a chemical storage buffer coupled to and moving with said automated chemical retriever”. These are two different elements. The automated chemical retriever retrieves the plates and the buffer acts as a temporary storage depot for addressable wells or plates. “By allowing a plate buffer to acquire addressable wells as they are retrieved by a storage and retrieval module, the transport routine of the storage and retrieval module can be designed to minimize retrieval time rather than retrieve addressable wells in a sequential order.” (patent application, page 20, lines 19-29).

While the Office Action states that in Davis et al. “one of the two substrate holders 22 or 23 can perform independently of the other holder; therefore, one substrate holder can temporarily hold one substrate, while the other substrate retrieves another substrate”, this is not same as the storage buffer described in the present invention. Each of the substrate holders 22 or 23 can either retrieve or replace a substrate. Neither of the substrate holders store a substrate. MPEP 2131 states that “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As shown above, Davis et al. fails to describe all of the elements, limitations, and relationships recited in as complete detail as is contained claim 22. Applicants have amended claim 22 to address the process or use limitations discussed in the Office Action. Accordingly, claim 22 is not anticipated by Davis et al. and the applicants respectfully request withdrawal of this rejection.

The Rejection of Claim 23 Under 35 U.S.C. §103(a)

Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. Applicants respectfully traverse this rejection.

Rejected dependent claim 23 depends on claim 22 and is patentable for at least the same reasons as describe above in regards to claim 22. Accordingly, applicants respectfully request that the rejection be withdrawn.

The Rejection of Claims 1-3, 20, 21 and 24 Under 35 U.S.C. §103(a)

Claims 1-3, 20, 21 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Armes et al. (U.S. Pat. No. 4,676,951). Applicants respectfully traverse this rejection.

The Office Action states that “Armes et al. teaches an apparatus comprising: a chemical library comprising storage locations (18); a computer controlled retriever (13); a transport path provided by the movement of the retriever (13); a plurality of automated liquid handling devices (14 & 15); and a user interface (12 & 16).” and “Armes et al. do not specifically teach the incorporation of at least 100,000 wells within the tray system.”

To establish a *prima facie* case of obviousness, the three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference as proposed by the Examiner; (2) there must be a reasonable expectation of success and (3) the prior art reference must teach or suggest all of the claim limitations. Applicants submit that all of the criteria has not been met in this case.

Armes et al. discloses “an automatic specimen analyzing system 10 is shown schematically. The system 10 is adapted to analyze biologic specimens which have been selectively treated as desired. The specimens are arranged in specimen trays wherein each tray contains a plurality of the specimens. The system 10 is adapted to automatically carry out, after the operator loads the specimen trays into the system 10, operations such as addition of reagents, incubation and the analysis.” (4,676,951, col. 6, lines 4-12). “The reagent delivery system 14 is selectively operable to administer a desired amount of at least one reagent to desired ones of the specimens in the tray through the remote dispensing head 15.” (4,676,951, col. 6, lines 28-32). Although Armes et al. does disclose the addition of chemicals into the wells using the reagent supply containers, there is no teaching of removing chemicals from the selected wells and dispensing those chemicals into other wells.

In contrast, the present invention discloses a liquid handler that can aspirate solutions from selected addressable chemical wells and programmable dispense them into addressable wells (patent application, page 10, lines 25-30). The liquid handler includes aspiration/dispensing heads (patent application, page 18, lines 4-7). To further clarify the invention, claims 1, 20, 24 have been amended to recite "a plurality of automated liquid handling devices having aspiration/dispensation heads".

Applicants submit that Armes et al. contains no reasonable suggestion or motivation to modify the reference. Since the overall purpose of Armes et al. is to analyze specimens, there is no motivation or suggestion to have the remote dispensing head aspirate solutions from the chemical wells. If solutions are required for Armes et al., the "The reagent delivery system ...utilizes a plurality of remote reagent supply containers and a means for selectively dispensing the desired amount of reagent from a corresponding supply container.." (4,676,951, col. 4, line 65 to col. 5, line 1). Since there already provisions for Armes et al. to add solutions to the wells, there no motivation to modify the system to remove solutions from the wells.

Applicants submit that there is no reasonable expectation of success. The dispensing head in Armes et al. is attached to remote reagent supply containers. Since there no provision for the dispensing heads to retrieve solutions from a chemical well for the Armes et al., there is no reasonable expectation of success to remove solutions from the wells.

Finally, Armes et al. does not teach or suggest all of the claim limitations. As pointed out above, there is no provisions in Armes et al capable of aspirating solutions from the chemical wells. Therefore, Armes et al. fails to teach or suggest all of the claim limitations as required.

In view of the foregoing, Applicants respectfully submit that amended claims 1, 20, 24, and their dependent claims 2, 3, 6, and 21, are allowable over the prior art of record and request withdrawal of the rejection. Reconsideration of the application and allowance of all pending claims are therefore earnestly solicited.

In re Application of
Stylli et al.
U.S. Serial No.: 09/252,842
Filed: February 19, 1999
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PATENT
Attorney Docket No.: AURO1160-1

Enclosed is a check in the amount of \$210.00 for the Two (2) Month Extension of Time fee. The Commissioner is hereby authorized to charge any other fees associated with the filing submitted herewith, or credit any overpayments to Deposit Account No. 50 -1355. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Date:

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